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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,270

04/26/2006

Dominic Berta

FE 6143 (US)

2471

34872

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07/17/2009

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EXAMINER

LENIHAN, JEFFREY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/577,270	Applicant(s) BERTA ET AL.	
	Examiner Jeffrey Lenihan	Art Unit 1796	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 06 July 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The proposed amendment introduces two new claims, claims 28 and 29, without canceling any of the finally rejected claims. Furthermore, the newly added claims recite new limitations regarding polymer polydispersity that were not presented in any previous version of the claims. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 14-27.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the examiner has not established that it would have been obvious to choose the catalysts of Winters because Pelliconi recites the use of catalysts disclosed in multiple patent documents. This is not persuasive. The fact that Pelliconi cites multiple references as disclosing catalysts which may be used in practicing the invention of WO 03/051984 does not negate the fact that Pelliconi specifically states that the bridged metallocene catalysts of Winters, US5145819, are suitable for use in preparing the disclosed composition (see page 5, lines 27-32). The examiner maintains the position that the explicit reference by Pelliconi to Winters renders the use of the catalysts disclosed by Winters to be prima facie obvious to one of ordinary skill in the art.

Regarding Pelliconi's preference for Ziegler Natta catalysts, it has been held that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments, see *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.). Also, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments, *In re Susi* 440 F.2d 442, 169 USPQ 423 (CCPA1971). As noted above, Pelliconi specifically states that the metallocene catalysts of Winters may be used in practicing the invention of WO 03/051984. The fact that Pelliconi prefers the use of Ziegler Natta catalysts does not overcome the broader disclosure that the metallocene catalysts of Winters may be used.

The examiner further notes that Pelliconi specifically states that the metallocene catalysts are particularly useful for the preparation of copolymers (a) and (b) (Page 5, last line, to Page 6, line 1), which correspond to components (B) and (C) of the claimed composition. As Pelliconi teaches that the individual components may be prepared in separate reactors and then blended together (Page 6, lines 2-9). In light of Pelliconi's statement that the metallocene catalysts are particularly suited for preparing copolymers (a) and (b), it would have been obvious to modify the composition of Pelliconi by using the catalysts disclosed by Winters to prepare copolymers (a) and (b), resulting in a final composition wherein component 1 of Pelliconi is prepared using a Ziegler Natta catalyst and component 2, comprising copolymers (a) and (b), is made with a metallocene catalyst. As the prior art renders obvious a composition comprising polymers having similar monomeric content made using the same catalysts, the examiner maintains that one of ordinary skill in the art would reasonably expect that the properties of the prior art composition would not be materially different from those of the claimed composition.

Regarding applicant's claim that unexpected results are obtained, the examiner notes that the allegedly unexpected results are not commensurate in scope with the instant claims. Applicant cites examples 2, 4, and 5 as evidence of unexpected results; Example 2 recites a composition comprising 70% component A, 20% component B, and 10% component C. Examples 4 and 5 both disclose compositions comprising 80% A, 13.33% B, and 6.67% C. The compositions disclosed in the cited examples therefore are not commensurate with the claimed composition, which may contain 50-90% A, 5-25% B, and 5-25% C. Furthermore, the examiner notes that, based on the data presented on pages 18-19 of the specification for the polymer components used, applicant has not demonstrated that the allegedly unexpected results may be obtained commensurate with the claimed ranges of properties such as polydispersity, melt flow rate, xylene soluble fractions, ethylene/propylene content, etc. which are used to define components A, B, and C in the claimed composition.

The examiner notes that the proposed amendment would overcome the rejection of claim 26 under 35 U.S.C. 112, 2nd paragraph.